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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,010	02/01/2002	Keith S. Karn	D/A1316 (1508/3560)	7862
7590 09/08/2005			EXAMINER	
Gunnar G. Leinberg, Esq. Nixon Peabody LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051			LAM, ANDREW H	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 09/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,010

Applicant(s)

KARN, KEITH S.

Examiner

Andrew H. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/01/02; 09/07/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Parry (U.S. 2003/0063309).

Regarding claim 1, Parry discloses a system (fig. 1, is a system for retrieving email using a printer) comprising a printing-capable device (fig. 1, email enabled printer 22) in communication (fig. 1, network 20) with a mail server (fig. 1, email server 16), wherein the printing-capable device has a user interface (fig. 1, LCD display 32, with touch screen) and retrieves email headers from the mail server (page 5, paragraph 0051, email enabled printer 22 is configured to extract the e-mail address in the "from" portion of the e-mail message), receives a user selection of an email header, retrieves an email message corresponding to a selected email header and prints the retrieved email message (page 4, paragraph 0040, in respond to a request from the e-mail client 28 the e-mail server 18 send the message to the e-mail enable printer 22 for printing).

Regarding claim 2, Parry discloses the system of claim 1 wherein the printing-capable device is a multi-function device (page 3, paragraph 0024, e-mail enable printer 22 may be a photographic printer--a photographic printer is a multi-function device because it is capable of copying and printing).

Regarding claim 3, Parry discloses the system of claim 1 wherein the printing-capable device is a printer (page 3, paragraph 0024, e-mail enable printer 22 may be a laser printer).

Regarding claim 4, Parry discloses the system of claim 1 wherein the printing-capable device is a copier (page 3, paragraph 0024, e-mail enable printer 22 may be a photographic printer--a photographic printer is a multi-function device because it is capable of copying and printing).

Regarding claim 5, Parry discloses the system of claim 1 wherein the printing-capable device is a facsimile machine (page 3, paragraph 0025, e-mail – capable facsimile machines).

Regarding claim 6, Parry discloses the system of claim 1 wherein the network is a local area network (page 2, paragraph 0022, communication link 26 may be a LAN, see fig. 1).

Regarding claim 7, Parry discloses the system of claim 1 wherein the network is a wide area network (page 2, paragraph 0022, communication link 26 may be a WAN, see fig. 1).

Regarding claim 8, Parry discloses the system of claim 1 wherein the network is at least one of an intranet or the Internet (page 2, paragraph 0022, communication link 26 may be a internet connection, see fig. 1).

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Regarding claim 9, Parry discloses the system of claim 1 wherein the printing-capable device retrieves an attachment associated with the retrieved email message and prints the retrieved attachment (page 4, paragraph 0040, the email message and attachment are received by the email enabled printer 22, a script associated with the e-mail client 28 then identifies the location of the attachment and place the data in the print queue, paragraph 0041).

Regarding claims 10-18 the claims recite limitations that are similar and in the same scope of invention as to those in claims 1-9 above and combination thereof; therefore, claims 10-18 are rejected for the same rejection rationale/basis as described in claims 1-9.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David Moore". The signature is fluid and cursive, with the first name "David" and last name "Moore" clearly distinguishable.

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600